

REMARKS

I. Introduction

Claims 1-22, 29-58, 65-76, and 78 are pending. Applicants have amended claims 1, 3, 7, 21, 22, 29, 37, 39, 43, 55, 57, 65, 73-76, and 78 to more particularly define the invention. No new matter would be added and the amendments are fully supported and justified by the specification. Applicants have also cancelled claims 5, 6, 41, and 42.

Claims 1-22, 29-58, 65-76 and 78 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hawkins et al. U.S. Patent No. 6,005,561 (hereinafter "Hawkins") in view of Houha et al. U.S. Patent No. 5,734,822 (hereinafter "Houha").

These rejections are respectfully traversed.

II. Applicants' Reply to the Rejection of  
Claims 1-22, 29-58, 65-76, and 78

Claims 1-22, 29-58, 65-76, and 78 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hawkins in view of Houha. Applicants respectfully traverse the Examiner's rejection. However, in the interest of advancing prosecution of this case, applicants have amended claims 1, 3, 7, 21, 22, 29, 37, 39, 43, 55, 57, 65, 73-76

and have set forth reasons why the amended claims are allowable.

Common to all of applicants' claims is applicants' interactive television program guide features of "determining the memory requirements of a non-program guide application that is not currently stored on the user television equipment" and "determining the amount of memory that will be available to the interactive television program guide after storing the non-program guide application on the user television equipment."

Applicants' approach further includes adjusting the amount of memory used by the interactive television program guide to store the program guide data. As set forth in applicants' claims, this adjustment is based at least in part on 1) information received by the system on the amount of memory to use to store the program guide data and 2) the amount of memory as determined to be available after storing the non-program guide application on the user television equipment.

The Examiner correctly acknowledges the novelty of applicants' approaches over Hawkins in stating that "it is not explicitly stated that this adjustment is in response to size information of the EPG transmitted from the headend" (Office Action, page 4). Nevertheless, the

Examiner contends that this deficiency in Hawkins can be made up with Houha. However, applicants respectfully submit that nowhere in Hawkins or Houha is it shown or suggested that adjusting the amount of memory used to store the program guide data is based on both the received information and the amount of memory determined to be available after storing the non-program guide application on the user television equipment. Rather, Hawkins, as the Examiner admitted, does not teach that "memory allocation is based upon the size information transmitted from the headend" (Office Action, page 6). Because Hawkins does not teach memory adjustment based on the received information, applicants respectfully submit that it cannot teach adjusting the memory based on both factors as recited in applicants' claims.

Moreover, applicants respectfully submit that these features of applicants' claims are not shown or suggested by Houha. The Examiner contends that Houha discloses applicants' features of memory adjustment because the "user terminal [of Houha] allocates the amount of memory to store downloaded software, in response to receiving size information from the headend" (Office Action, page 6), and that it would have been obvious to combine this teaching of Houha with that of Hawkins.

However, it should be noted that Houha makes clear that its memory allocation is based only on "how large various parts of the load stream will be" and then "transmits this size information in advance to the terminal, which thereafter need only allocate the minimum amount of memory required" (Houha, column 2, lines 45-49). Houha fails to show or suggest that the memory allocation is also based on the amount of memory available after installation of a non-program guide application. Accordingly, neither Hawkins nor Houha, either alone or in combination, show or suggest all of the features of applicants' claims.

Applicants respectfully submit that the § 103 rejection must be withdrawn for another independent reason. The Office Action failed to provide sufficient motivation for combining the references to justify the assertion of a § 103 rejection. In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998) ("When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references"); see also MPEP § 2142 and 2143.01. It is well-settled that an Office Action can "satisfy this burden only by showing some objective teaching ... that would lead [one of ordinary skill in the art] to combine the relevant teachings of the

references." In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988).

The Office Action, instead of providing objective evidence of a motivation to combine Hawkins with Houha, merely relies on various conclusions of obviousness that simply states the benefits of applicants' invention:

It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Hawkins to include allocating memory in response to size information received from a headend, with respect to software to be downloaded, at least for the desirable advantage of avoiding wasting large amounts of temporary storage space, as taught by Houha. (Office Action, page 6)

Such "[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'" of a motivation to combine. In addition, relying solely on applicants' "disclosure as a blueprint for piecing together the prior art to defeat patentability" is insufficient as a matter of law. In re Kotzab, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000); In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999); see also In re Lee, 61 U.S.P.Q.2d 1430, 1433 (Fed. Cir. 2002) ("The factual inquiry of whether to combine references must be thorough and searching"); MPEP § 2143.

Accordingly, for at least these reasons, applicants respectfully request that the rejection of

claims 1-22, 29-58, 65-76, and 78 under 35 U.S.C. § 103(a)  
be withdrawn.

III. Conclusion

In view of the foregoing, claims 1-4, 7-22, 29-40, 43-58, 65-76 and 78 are in condition for allowance. This application is therefore in condition for allowance. Reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,



Philip R. Poh  
Registration No. 51,176  
Agent for Applicants  
FISH & NEAVE  
1251 Avenue of the Americas  
New York, New York 10020-1104  
Tel.: (212) 596-9000